

II. Objection to Information Disclosure Statement Under 37 C.F.R. 1.98(a)(3)

In the Office Action the Information Disclosure Statement submitted on September 14, 2000 was not considered because a concise explanation of the relevance as presently understood by the individual was not included.

Applicants hereby submit that the requirements of 37 C.F.R. 1.98(a)(3) have been satisfied and that the reference should be considered. Referring to the September 14, 2000 submittal item 2, an English language version of a foreign search report was submitted. EP 0473064, not in the English language, was included in the Information Disclosure Statement. The relevance of the citation is based upon an independent assessment of an Examiner who specifically noted the same reference. Applicants hereby state that the search was done in conjunction with the Foreign Associate in the Federal Republic of Germany on August 22, 2000 in a search before the European Patent Office under EP 99 10 1469, an application before the European Patent Office for a like method and apparatus as disclosed in the current application. Applicants resubmit for consideration EP 0473064 and now include an English abstract for the same.

III. Objection to Incorporation by Reference Document EP 0411572

In the Office Action, it was stated that EP 0411572 could not be incorporated by reference into the specification of the current application. According to the Examiner, this is because EP 0411572 is a foreign application or patent.

In response, Applicants have amended the specification to remove the incorporation by reference language rendering the objection moot.

IV. Rejection of Claim 5 Under 35 U.S.C. 112 second paragraph

In the Office Action claim 5 was rejected under 35 U.S.C. 112 second paragraph as failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. As mentioned in the Office Action, "it was not clear what step is inferred by "placing the partial bundles in a first collection trough of a collection device."

In response, Applicants have amended claim 5 to comply with 35 U.S.C. 112 second paragraph to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The offending material inside claim 5 has been deleted through this amendment. As a result of amended claim 5, it is respectfully submitted that the rejection has been obviated and that the rejection should be withdrawn.

V. Rejection of Claim 1 Under 35 U.S.C. § 103

Claim 1 was rejected under 35 U.S.C. § 103 as anticipated by U.S. Patent No. 4,044,438 (Everhart) in view of U.S. Patent 5,927,819 (Philipp et al.). Applicants respectfully submit that claim 1 is not obvious in view of the Everhart and the Philipp et al. references, either singularly or in combination for the following reasons.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This

teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Office Action contends that a prior art reference must either be in the field of applicants endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicants was concerned, in order to be relied upon as a basis for rejection of the claimed invention. The Office Action states that the Everhart reference teaches transporting of cut bundles using both binder means and suction means and the Philipp et al. reference teaches the use of a gripper. It is contended that both references are reasonably pertinent to the particular problem which the Applicants are concerned, that is, how to transport a bundle of strands more reliably regardless of whether the bundles is bound or not.

Applicants hereby respectfully submits that the Everhart and Philipp et al. references cannot be successfully combined together to form a proper rejection for claim 1. As dictated in MPEP 2143.01, "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

First, Everhart does not teach, suggest or motivate to combine with the Philipp et al. reference. Likewise, the Philipp et al. reference is silent as to potential

teaching, suggestion or motivation to be combined with Everhart. Second, a person of ordinary skill in the art, here production of fiber bundles, would not have combined or modified the teachings of the Philipp et al. reference and Everhart to allow a rejection under 35 U.S.C. 103. A person skilled in production of fiber bundles would not have combined methodologies employed in trimming and end-rounding tooth brushes with that of production of yarn balls. As the fields of endeavor of the references are not related, it would not have been apparent or reasonable to combine such diverse references.

Amended claim 1 relates to a method for manufacturing fiber bundles comprising transporting a fiber bundle using at least one feed element; cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length; releasing the unbound partial bundles from the at least one feed element; gripping the unbound partial bundles using at least one gripping element; releasing the unbound partial bundles from the one gripping element; and placing the unbound partial bundles in a first collection trough of a collection device.

The Office Action contends that the cutting step of claim 1 merely calls for "cutting the fiber bundle strands into partial bundles, the partial bundles having a length" and that Everhart teaches a step of cutting strands into partial bundles wherein the partial bundles have a length. Recognizing a distinction between the prior art and Applicants disclosed invention, the Examiner points out claim 1 does not recite any steps to preclude that the **strands** are bound together before the cut.

In response, Applicants respectfully submit that amended claim 1 now recites a step that precludes any binding before a cut is made. Reviewing the specific wording of claim 1, the method entails transporting a fiber bundle (emphasis added for clarity of the singular nature of the description) using at least one feed

element; and cutting the fiber bundle strand (again singular) into partial bundles (now plural). As is evident upon review, the singular bundle is inherently unbound in the transporting section and there are no "strands" which are "bound together" as alluded to in the Office Action.

Contrary to the requirements of claim 1 above, as pointed out in the Office Action, Everhart Column 5 lines 19-31 requires that the yarn bundles are **bound prior to cutting** (See, Everhart, Column 3 line 40 to Column 4 line 34). Everhart requires binding of the yarns, with binder wire 42 (Column 3 lines 45 to 60). The binding helps encircle the bundle of yarns to "tightly bind together the individual yarns in spaced apart relationship." Everhart does not disclose or suggest cutting unbound yarn as the purpose of producing the yarn ball would then be defeated.

The Philipp et al. reference does not satisfy the defects of the Everhart patent. The Philipp et al. reference is limited, as stated in the Office Action, to showing grippers both advancement type 32 and hold type 30. The Philipp et al. reference does not disclose or suggest the cutting of unbound fiber bundles as required in amended claim 1.

As a result of the references failing to disclose or suggest the features of claim 1, rejection under 35 U.S.C. 103 is inappropriate and should be withdrawn.

VI. Rejection of Claim 5 Under 35 U.S.C. § 103(a)

Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over Everhart in view of the Philipp et al. reference as applied to claim 1 and further in view of United States Patent 3,951,022 (Hurtes). Applicants respectfully submit that the references either singularly or in combination do not render obvious claim 5 for

the following reasons.

Amended claim 5 requires the elements of claim 1 with the added step of rotating the collection device after the first collection trough is filled and placing the partial bundles in a further collection trough.

As stated in the Office Action, the Hurtes reference teaches a horizontal advancement means which includes a plurality of guides with each successive guide being incrementally positioned by a pair of rollers and index means in order for each guide to accommodate a segment of fibers. The Office Action then states that Hurtes teaches a rotating collection device and that it would have suggested to one having ordinary skill in the art to provide a rotating collection device on the modified device of Everhart since doing so would provide a device capable of automatically collecting a desired amount of product in each of multiple collection locations without interruption to the process to replace a collection location after it is filled with a new collection location. The Hurtes reference does not cure the defects of the Everhart and Philipp et al. references. The Hurtes reference is limited in its scope and applicability. Hurtes does not describe or suggest cutting of unbound fibers needed to cure the defects of the Everhart and Philipp et al. references. Hurtes is only used in the Office Action to potentially provide "a horizontal advancement means" for collecting fibers. As a result of Hurtes failing to cure the defects of Everhart and Philipp et al, claim 5 is patentable at least for the reasons as presented in relation to claim 1. It is respectfully submitted that the rejection be withdrawn.

VII. Conclusion

Attached hereto is a marked-up version of the changes made to the

claims by the current Amendment. The attached page is captioned "**Version with Markings to Show Changes Made.**"

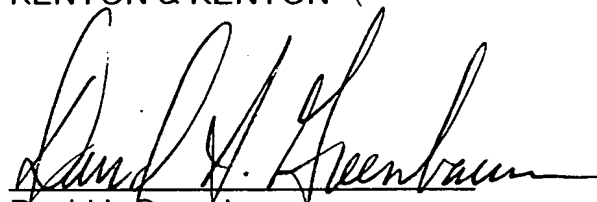
It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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Dated:

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Version with Markings to Show Changes Made

IN THE CLAIMS:

Please amend claims 1 and 5 as follows:

1. (Twice Amended) A method for manufacturing fiber bundles comprising:
transporting a fiber bundle using at least one feed element;
cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length;
releasing the unbound partial bundles from the at least one feed element;
gripping the unbound partial bundles using at least one gripping element;
releasing the unbound partial bundles from the at least one gripping element; and
placing the unbound partial bundles in a first collection trough of a collection device.

5. (Amended) The method as recited in claim 1, further comprising: [placing the partial bundles in a first collection trough of a collection device,] rotating the collection device after the first collection trough is filled and placing the partial bundles in a further collection trough.